

## **REMARKS/ARGUMENTS**

The Advisory Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Final Office Action.

### ***Double Patenting***

The Examiner seems to have maintained a statutory rejection to claims 1, 13, 24 and 30 and the intervening claims of the present application in view of claims 1, 5, 16 of U.S. Patent No. 6,644,645. The Applicant respectfully submits that due to the amendments made to the claims (as discussed below), the statutory-type double patenting rejection is moot. In particular, US Patent No. 6,664,645 does not describe the claim limitations, such as, for example, "time-varying position information".

### ***Claim Rejections 35 USC § 103***

Claim 1 of the present application has been amended to include the subject matter of previously added claim 39. Accordingly, claim 39 has been cancelled from the application.

The Applicant respectfully submits that the amended claim 1 is patentable over Wolff in view of Sekendur.

In particular, it will be appreciated that, as stated in MPEP 2143:

*to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

The Applicant respectfully maintains that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify Wolff with Sekendur, or to combine the reference teachings in order to obtain the claim limitations.

In particular, Wolff only enables a person skilled in the art to apply the invention described in Wolff towards reading pre-printed barcodes used for identifying document pages and other application defined areas (see abstract, column 10 line 6). However, as asserted by the Examiner on pages 10 to 11 of the Final Office Action, Wolff does not describe indicating data including time varying position information regarding movement of the sensing device relative to the form. Wolff only describes determining movement of the pen instrument due to sensing the motion of the pen instrument and forces applied thereto (see column 9 line 27 to column 10 line 10).

In any event, the Examiner has stated that Sekendur describes obtaining time varying position information regarding the movement of the sensing device by sensing coded data and not the forces applied to the pen instrument, as in Wolff. Thus, the Applicant respectfully submits that as Sekendur teaches away from the teaching of Wolff, then Sekendur cannot be combined with Wolff. In particular, the Applicant highlights MPEP 2143.01 which states:

*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*

Therefore, as Wolff determines movement of the sensing device by sensing forces applied to the sensing device, and Sekendur determines movement of the sensing device by sensing coded data, it would not be obvious for a person skilled in the art to combine Wolff with Sekendur.

Hence, as there is no suggestion or teaching in the prior art references themselves, and as Wolff and Sekendur teach away from each other, and the references do not suggest the desirability of the combination, a person skilled in the art would not combine Wolff with Sekendur, and thus, the amended claim 1 is not prima facie obvious.

In any event, the present amended claim 1 describes the coded data of a form being indicative of the identity of the form, position information of the sensing device relative to the form, and time varying position information regarding movement of the sensing device relative to the form. It will be appreciated by the Examiner that a combination of Wolff and Sekendur does not describe these claims limitations.

In particular, if a person skilled in the art were to combine Wolff with Sekendur, the combination would describe the barcode of Wolff, having identity information and the co-ordinates of Sekendur, from which the pen may determine movement. The combination of Wolff and Sekendur would therefore require two types of coded data, and two separate actions from a sensing device.

Thus, a sensing device would sense the barcode in order to obtain the identity of the page, and then proceed to sense co-ordinates such that the movement of the pen can be determined.

The amended claim 1, however describes the coded data being indicative of the identity of the form, at least one reference point of the form, and the time varying position information of the sensing device. Thus, the sensing device of claim 1 may obtain the identity of the form, at least one reference point of the form and the time varying position information in just one action of sensing coded data.

In the advisory action, the Examiner has stated that "the fact that (the) applicant has recognised another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the references would otherwise be obvious". The applicant respectfully submits that neither Skenedur, Wolff, nor a combination thereof suggests or teaches obtaining, from sensing the coded data the identity of the form, at least one reference point of the form, and the time verifying position information. This is not just an advantage of claim 1, this is a requirement of the claim, as described by the claim and not described in any of the cited prior art documents.

Additionally, the Examiner has stated that Wolff describes "other types of form with electronically coded data that do not include barcode". The Examiner has referred the applicant to column 2, lines 52 through to column 3, line 24. The applicant respectfully submits that the Examiner has misinterpreted Wolff. Wolff describes the barcode system being applied to various application areas. This is shown by the description of having the barcode system applied to a Calendar Book (for example, see column 3, lines 44 to 46), where "an area is set aside for the barcode identifier".

Hence, as the combination of Wolff and Sekendur does not teach all of the claim limitations, the present amended claim 1 is patentable over Wolff in view of Sekendur.

In any event, to further clarify these distinctions over the cited prior art, the Applicant has amended claim 1 to describe that the coded data includes coded data portions, where each coded data portion is indicative of the at least one reference point of the form and the identity of the form. It will be appreciated by the Examiner that this feature of is not shown in any of the prior art documents. Accordingly, claim 39 has been deleted from the application.

In particular, Sekendur describes a "surface systematically coded with a plurality of dots 1 in Fig. 1 designating co-ordinates" (see column 4, lines 28 - 30). Sekendur further describes each dot being divided into concentric circles, partitioned into quadrants, where the quadrants represent a digit of a four digit number. The light/dark combinations of slices within quadrants combine to indicate an X-Y co-ordinate within each dot (see column 4, lines 28 - 41). In contrast to claim 1, Sekendur does not describe the coded data having a plurality of coded data portions, where each coded data portion is indicative of an identity of the form and of at least one reference point of the form.

Additionally, with respect to Wolff, Wolff describes barcodes applied to different applications (as described above). Wolff does not describe having each barcode portion being indicative of an identity of form and of at least one reference point of the form.

Thus, the amended claim 1 is patentable over Sekendur, Wolff, and a combination thereof.

Similar amendments have been made to independent claims 13, 24, and 30, with claims 36 to 38 being cancelled from the application, and similar arguments apply with respect to these other independent claims.

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the pending claims, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

Applicants:



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